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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,687	05/31/2001	Patricia Kesling	XMS-102	8151

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EXAMINER	
DEAN, RAYMOND S	

ART UNIT	PAPER NUMBER
2684	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,687	KESLING ET AL.	
	Examiner	Art Unit	
	Raymond S. Dean	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0701*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on June 15, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's arguments, see Appeal Brief filed June 15, 2005, with respect to the rejection(s)of claim(s) 1 - 19 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Regarding Claims 1, 11, and 18, Examiner has taken another look at the Logan reference and agrees with Applicants that Logan does not teach charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received. Palmer et al. (5,905,865), hereafter Palmer, teaches

charging a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received (See Column 7 lines 7 – 26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the broadcast method taught by Palmer in the system of Noreen for the purposes of adding value to the broadcast system of Noreen by manipulating internet connections thus enhancing the advertising by making more complete information and options available to users and generating a revenue stream as taught by Palmer.

Regarding Claim 6, Examiner has taken another look at the Parella reference and agrees with Applicants that Parella does not teach comparing the first quantity of electronic indications with the second quantity of electronic indications. Hyodo (5,937,390), hereafter Hyodo, teaches comparing a first quantity of indications with a second quantity of indications to determine the effectiveness of different advertisements (See Column 6 lines 65 – 67, Column 7 lines 1 – 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the comparison method of Hyodo in the system of Noreen for the purpose of enabling the advertiser to determine the effectiveness of different advertisements as taught by Hyodo.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 – 3, 5, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Palmer et al. (5,905,865).

Regarding Claim 1, Noreen teaches a method for charging advertising fees, comprising the steps of: broadcasting an advertisement for a sponsor in a broadcast (Column 13 lines 15 – 32), wherein the broadcast includes an identifier that uniquely identifies the advertisement and at least one of the sponsor of the advertisement and a product advertised in the advertisement (Column 13 lines 15 – 32); receiving a quantity of electronic indications from persons who observe the advertisement, wherein the indications indicate interest in the product, and wherein the indications reference the identifier (Column 13 lines 33 – 67).

Noreen does not teach charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received.

Palmer teaches charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received (Column 7 lines 7 – 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the broadcast method taught by Palmer in the system of Noreen for the purposes of adding value to the broadcast system of Noreen by manipulating internet connections thus enhancing the advertising by making more complete information and options available to users and generating a revenue stream as taught by Palmer.

Regarding Claim 2, Noreen in view of Palmer teaches all of the claimed limitations recited in Claim 1. Noreen further teaches a time at which and a channel on which the advertisement was broadcast (Column 13 lines 23 – 27, the carrier frequency is the channel).

Regarding Claim 3, Noreen in view of Palmer teaches all of the claimed limitations recited in Claim 1. Noreen further teaches receiving one of wireless messages requesting more information about the product and wireless messages requesting to purchase the product (Column 13 lines 42 – 67).

Regarding Claim 5, Noreen in view of Palmer teaches all of the claimed limitations recited in Claim 1. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 18, Noreen teaches a method for charging advertising fees comprising the steps of: broadcasting an advertisement associated with a plurality of sponsors (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers, this includes an advertisement associated with a plurality of sponsors); broadcasting a unique program identifier with the advertisement (Column 13 lines 15 – 32); receiving a wireless order message to buy a product of a sponsor of the plurality of sponsors, wherein the wireless order message references the unique program identifier (Column 13 lines 33 – 67).

Noreen does not teach charging the sponsor a fee for the wireless order message received to buy the product of the sponsor.

Palmer teaches charging the sponsor a fee for the order message received to buy the product of the sponsor (Column 7 lines 7 – 26, in order for an order message to be received the website will need to be accessed thus generating a hit).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the broadcast method taught by Palmer in the system of Noreen for the purposes of adding value to the broadcast system of Noreen by manipulating internet connections thus enhancing the advertising by making more complete information and options available to users and generating a revenue stream as taught by Palmer.

Regarding Claim 19, Noreen in view of Palmer teaches all of the claimed limitations recited in Claim 18. Noreen further teaches broadcasting form at least one satellite (Figure 1, Column 12 lines 12 – 15).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Palmer et al. (5,905,865) and in further view of Crosby et al. (US 6,628,928).

Regarding Claim 4, Noreen in view of Palmer teaches all of the claimed limitations recited in Claim 1. Noreen in view of Palmer does not teach receiving downloads of the identifiers at a central hub.

Crosby teaches receiving downloads of the identifiers at a central hub (Column 6 lines 4 – 42, the network operations center is the central hub).

Noreen in view of Palmer and Crosby teach a radio that receives digital audio broadcasts thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the central hub method taught above by Crosby in the digital audio broadcast system of Noreen in view of Palmer for the purpose of allowing the user of said radio to review requested information at a later time via the internet using said user's computer thus said user can review said information at said user's leisure.

6. Claims 6 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Hyodo (5,937,390).

Regarding Claim 6, Noreen teaches broadcasting a first advertisement including a first identifier; receiving a first quantity of electronic indications from persons who observe the first advertisement, wherein the first quantity of electronic indications indicate interest in the first advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers) and wherein the first quantity of electronic indications reference the first identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers); broadcasting a second advertisement including a second identifier; receiving a second quantity of electronic

indications from persons who observe the second advertisement, wherein the second quantity of electronic indications indicate interest in the second advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers), and wherein the second quantity of electronic indications reference the second identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers).

Noreen does not teach comparing the first quantity with the second quantity.

Hyodo teaches comparing the first quantity with the second quantity (Column 6 lines 65 – 67, Column 7 lines 1 – 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the comparison method of Hyodo in the system of Noreen for the purpose of enabling the advertiser to determine the effectiveness of different advertisements as taught by Hyodo.

Regarding Claim 7, Noreen in view of Hyodo teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same and wherein the step of broadcasting the first advertisement occurs at a different time of day than the step of broadcasting the second advertisement (Column 4 lines 23 - 40, this is a digital broadcast radio satellite

system that broadcasts multiple content nationwide to multiple subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 8, Noreen in view of Hyodo teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same, and wherein the step of broadcasting the first advertisement occurs on a different channel than the step of broadcasting the second advertisement (Column 4 lines 23 – 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 9, Noreen in view of Hyodo teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are different, wherein the first advertisement is broadcast at a particular time of day and on a certain channel, and wherein the second advertisement is broadcast at the particular time of day and on the certain channel (Column 4 lines 23 – 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels thus this is an inherent characteristic).

Regarding Claim 10, Noreen in view of Hyodo teaches all of the claimed limitations recited in Claim 6. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

7. Claims 11 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Steele et al. (US 2002/0046084 A1) in further view of Crosby et al. (US 6,628,928 B1) and in further view of Palmer et al. (5,905,865).

Regarding Claim 11, Noreen teaches a method for charging advertising fees comprising the steps of: broadcasting an advertisement of a sponsor and broadcasting a unique program identifier with the advertisement (Column 13 lines 15 – 32).

Noreen does not teach recording the unique program identifier in memory devices in response to users' indicating interest in the advertisement.

Steele teaches recording the unique program identifier in memory devices in response to users' indicating interest in the advertisement (Section 0046 lines 1 – 5, Section 0063).

Noreen and Steele both teach a digital radio that receives digital audio broadcasts thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the recording method taught above in Steele in the digital radio in Noreen for the purpose of allowing a user to play back digital audio files at a later time that is convenient for said user.

Noreen in view of Steele does not teach downloading the unique program identifier from the memory devices to a central hub.

Crosby teaches downloading the unique program identifier from the memory devices to a central hub (Column 6 lines 4 – 42, the network operations center is the central hub).

Noreen in view of Steele and Crosby teach a radio that receives digital audio broadcasts thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the central hub method taught above by Crosby in the digital audio broadcast system of Noreen in view of Steele for the purpose of allowing the user of said radio to review requested information at a later time via the internet using said user's computer thus said user can review said information at said user's leisure.

Noreen in view of Steele and in further view of Crosby does not teach charging the sponsor for each unique program identifier that is downloaded.

Palmer teaches charging the sponsor for each unique program identifier (Column 7 lines 7 – 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the broadcast method taught by Palmer in the system of Noreen in view of Steele and in further view of Crosby for the purpose of adding value to the broadcast system of Noreen in view of Steele and in further view of Crosby by manipulating internet connections thus enhancing the advertising by making more complete information and options available to users and for the purpose of generating a revenue stream as taught by Palmer.

Regarding Claim 12, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 11. Steele further teaches downloading to a portable device via one of a wireless and a temporary wired connection and employing the portable device to effect the downloading (Section

0070 lines 3 – 5, the connection to the internet gateway is a temporary wired connection).

Regarding Claim 13, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 12. Steele further teaches a personal digital assistant (Section 0072 lines 3 – 4).

Regarding Claim 14, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 12. Steele further teaches one of an infrared link and a radio frequency link (Section 0072 line 3).

Regarding Claim 15, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 11. Noreen further teaches presenting a second advertisement of a sponsor (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements), Crosby further teaches a central hub (Column 6 lines 4 – 42), receiving click-through commands from users to activate the second advertisement (Column 6 lines 4 – 42, the user can access websites via the internet to purchase advertised products thus the click-through commands are inherent); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Column 6 lines 4 – 42, the user can access websites via the internet to purchase advertised products thus an order screen is inherent); accepting an order for the product and associating the order with the unique program identifier (Column 6 lines 4 – 42, the user can access websites via the internet

to purchase advertised products thus accepting an order for said advertised product is inherent); Palmer further teaches charging the sponsor a commission on the order (Column 7 lines 7 – 26, in order for an order message to be received the website will need to be accessed thus generating a hit).

Regarding Claim 16, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 11. Noreen further teaches presenting a second advertisement of a second sponsor (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements), Crosby further teaches a web site (Column 6 lines 4 – 42), receiving click-through commands from users to activate the second advertisement (Column 6 lines 4 – 42, the user can access websites via the internet to purchase advertised products thus the click-through commands are inherent); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Column 6 lines 4 – 42, the user can access websites via the internet to purchase advertised products thus an order screen is inherent); accepting an order for the product and associating the order with the unique program identifier (Column 6 lines 4 – 42, the user can access websites via the internet to purchase advertised products thus accepting an order for said advertised product is inherent); Palmer further teaches charging the sponsor a commission on the order (Column 7 lines 7 – 26, in order for an order message to be received the website will need to be accessed thus generating a hit).

Regarding Claim 17, Noreen in view of Steele in further view of Crosby and in further view of Palmer teaches all of the claimed limitations recited in Claim 11. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S. Dean whose telephone number is 571-272-7877. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus. Most facsimile-transmitted patent application related

correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Raymond S. Dean
July 8, 2005

NAY MAUNG
SUPERVISORY PATENT EXAMINER